

REMARKS

Applicants respectfully request reconsideration of the present application in view of these remarks. In particular, applicants ask that Examiner Cook reconsider her interpretation of certain Federal Circuit decisions, advanced in support of allowing neither claim 1 nor claim 3.

As to both claims, the examiner asserts that “there is no requirement that the prior art ... suggest that the claimed [*sic?*: ‘prior art’] product ... have the same or similar utility as that discovered by applicant” (page 6, section 6). Yet, in sharp contrast to the circumstances at bar in *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990), the presently cited art discounts for CB10 peptide any practical utility, as opposed to its mere use, in the examiner’s words, “to identify antibodies to CB10 in patient samples.”

The Federal Circuit in *Dillon* found that the prior art evidenced motivation to have made a particular type of compound, where the applicant at bar, also claiming compounds of that type, have discovered a new advantage for them. In the present application, however, the prior art not only fails to disclose a kit as claimed but also teaches away from any reason for assembling such a kit. According to both Boisser (1991) and Cremer (1992), in other words, there was no reason “to identify antibodies to CB10 in patient samples,” a purpose that offers itself now through impermissible hindsight alone.

For this reason, both claim 1 and claim 3 are patentable over the combination of references founded on Boisser (1991) and Cremer (1992), respectively. As to claim 3, moreover, the examiner misinterprets the law in her blanket pronouncement that “instructions in a kit cannot serve to define the kit over the prior art.”

The decision in *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), does not stand for this *per se* rule, which likewise is inconsistent with *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), which the action also invokes. Thus, the court in *Ngai* referred to the principle from *Gulack* that instructions in a kit should have patentable weight when “the printed matter and the [correlated aspects of the claimed invention] were interrelated, so as to produce a new product useful for ‘educational and recreational mathematical’ purposes,” which were those of the

invention at issue in *Gulack*. By the same token, instructions to apply CB10, out of a kit as recited in claim 3, for "indicating the development of rheumatoid arthritis," are so interrelated with the other kit component -- namely, means (ii) -- as to produce a product that is a "new product," à la *Gulack*, by virtue of a prognostic utility that is not presaged by but rather is discouraged by the cited art.

Applicants submit, therefore, that the present claims are in condition for allowance. Favorable reconsideration of the application is respectfully requested, therefore. Also, Examiner Cook is invited to contact the undersigned, should she feel that a telephone interview could advance prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 CFR §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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